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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,472	01/29/2004	Christopher G. Walls	3962 P 019	3613

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PAUL J. NYKAZA, ESQ.
WALLENSTEIN WAGNER & ROCKEY, LTD.
53RD FLOOR
311 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6630

EXAMINER

SCHRODE, WILLIAM THOMAS

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,472

Applicant(s)

WALLS ET AL.

Examiner

William Schrode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/23/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first configuration of the connection must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 5-7, 25, 33 are objected to because the preambles are inconsistent. In regard to claims 5-7, the preamble is referring to the adaptor but the preamble of independent claim 1 is referring to an assembly. In regard to claim 25, the preamble is referring to the lock assembly but the preamble of independent claim 16 is referring to an adaptor. In regard to claim 33, the preamble is referring specifically to the lock but the preamble of the independent claim 26 is referring to a lock assembly.

Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 25 claims different configurations for the lock assembly and does not further limit the adaptor claimed in independent claim 16.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5, 6, 7, 9, 10, 15 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "the adaptor body" in line 1. There is insufficient antecedent basis for this limitation in the claim.

In regard to claims 9, 10, and 15 the scope of the claim is unclear because the applicant discloses in the independent claim that the actuator and the extension bolt are

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separated by a length generally transverse to the extension bolt axis, then, the applicant claims in a dependent claim that the actuator is secured directly to the extension bolt.

This makes the scope unclear because the applicant is claiming two separate inventions. Therefore, the scope of these dependent claims contradict the scope of claim 1. Thus, these claims are indefinite and will not be further treated until appropriate correction is made.

In regard to claim 25, the scope of the claim is unclear because the assembly was not previously positively claimed and the examiner is unclear if the assembly is part of the invention. The examiner is considering the assembly as being positively claimed until further clarification is provided.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 8-12, 14-17, 20-29 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagstrom (US 1,094,143). In regard to claim 1, Hagstrom discloses a locking door assembly, comprising; a door member (1) mounted to a door frame (3) and moveable between at least an open and closed position; a lock assembly having a central lock member (6), and at least one actuator member (38) connected to the central lock member and moveable along an axis of extension between a first position and second position; and an extension bolt (51, 46, and 45) having a elongated

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body (51) extending along an extension bolt axis, and having a proximal end (52) connected to the actuator member and a distal end with a projection configured to mate with a receiver (i.e. 45 mating with 44) for locking the door in position, the connection of the actuator to the extension bolt including an intermediate portion with a length (length of 53) extending generally transverse to the extension bolt axis and defining an extent of separation of the extension bolt axis from the actuator axis and at least an extent of the extension bolt passing through an interior portion of the door member.

In regard to claim 2, Hagstrom discloses an assembly wherein the intermediate portion comprises an adaptor (40, 41, 54, 55, 56, and 53) with a body length located between the actuator and the extension bolt, the body length defining a separation distance between the actuator axis of extension and the extension bolt axis.

In regard to claim 3, Hagstrom discloses an assembly wherein the adaptor has a first end (end of 41) connected to the actuator and a second end (the end connected to 52) connected to the extension bolt.

In regard to claim 5, Hagstrom discloses an assembly wherein the length of the adaptor is a fixed length.

In regard to claim 8, Hagstrom discloses an assembly wherein a second adaptor (60) is secured to a second extension bolt (61) positioned along the extension bolt axis, the second adaptor having an intermediate portion with a length extending transverse to said extension bolt axis.

In regards to claim 9, Hagstrom discloses an assembly wherein the intermediate portion of the connection of the actuator to the extension bolt is capable of alternate

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connection by the user, the alternate connection including a first configuration of connection whereby the axis of the extension bolt is capable of being in substantial alignment with the actuator axis, and a second configuration whereby the axis of the extension bolt resides a distance away from the actuator. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Further, since Hagstrom discloses all of the structural features of the claim, his device would inherently be capable of performing the same functions as applicant's invention.

In regard to claim 10, "as best understood" Hagstrom discloses an assembly wherein the actuator is capable of being secured to the extension bolt when the assembly is in a first configuration.

In regard to claim 11, Hagstrom discloses a multi-point assembly for a door member mounted to a door frame and moveable between an open configuration and a closed configuration, comprising; a central lock assembly (6) having at least one actuator (38) member moveable along an axis of movement between a first position and second position; an extension bolt (51, 46, and 45) having a elongated body (51) extending along an extension bolt axis, and having a proximal end (52) connected to the actuator member by an adaptor (40, 41, 54, 55, 56, and 53), the adaptor having a body portion (53) residing between a first end (41) and a second end (the end connected to 52), the body portion having a length extending generally transverse to the extension bolt axis to displace the extension bolt axis a distance away from the actuator axis.

In regard to claim 12, Hagstrom discloses the lock assembly wherein the first end of the adaptor is connected to the actuator and the second end is connected to the extension bolt, said length of the body portion being defined a distance between the first and second ends of the adaptor.

In regard to claim 14, Hagstrom discloses the lock assembly wherein a second adaptor (60) is secured to a second extension bolt (61) positioned along a second extension bolt axis, the second adaptor having a body portion with a length extending transverse to said second extension bolt axis.

In regard to claim 15, Hagstrom discloses an assembly wherein the intermediate portion of the connection of the actuator to the extension bolt is capable of alternate connection by the user, the alternate connection including a first configuration of connection whereby the axis of the extension bolt is capable of being in substantial alignment with the actuator axis, and a second configuration whereby the axis of the extension bolt resides a distance away from the actuator. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Further, since Hagstrom discloses all of the structural features of the claim, his device would inherently be capable of performing the same functions as applicant's invention.

In regard to claim 16 and 25, Hagstrom discloses an adaptor for connecting an extension bolt to a central lock device of a multi-point lock assembly for a door, comprising; an adaptor (40, 41, 54, 55, 56, and 53) body having a first end (41) with a

means for connection to a mating portion of a moveable actuator member (38) of a central lock member (6), and a second end (at 52) with a means for connection to an elongated extension bolt (51, 46, and 45), the adaptor having a body length (53) between the first end and the second end, the body length extending transverse to the elongated extension bolt, the length providing an extent of positioning the elongated extension bolt in spaced relationship from the actuator. In reference to claim 25, the claim recites limitations for a lock assembly and does not further limit the adaptor in independent claim 16. The assembly in claim 25 is not positively claimed.

In regard to claim 17, Hagstrom discloses an adaptor wherein the means for connecting the adaptor first end to an actuator member includes a projection (40) at the first end configured to mate with a receiver (39) of the actuator member.

In regard to claim 20, Hagstrom discloses an adaptor wherein the first end of the adaptor is capable of removable connection to the actuator.

In regard to claim 21, Hagstrom discloses an adaptor wherein the second end of the adaptor is capable of removable connection to the extension bolt.

In regard to claim 22, Hagstrom discloses an adaptor wherein the length of the adaptor body is fixed length.

In regard to claim 26, Hagstrom discloses an adaptable door lock assembly for a multi-point locking arrangement of a door frame, comprising; a central lock unit (6) having a movable actuator member (38) with an axis of movement between an extended position and a retracted position, said actuator member being connected to an extension bolt (51, 46, and 45) extending along a bolt axis, the connection of the

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actuator member to the extension bolt being capable of alternate connection by a user, the alternate connection including a first configuration whereby the axis of the actuator is in alignment with the bolt axis, and a second configuration whereby the axis of the actuator resides a distance away from the bolt axis. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Further, since Hagstrom discloses all of the structural features of the claim, his device would inherently be capable of performing the same functions as applicant's invention.

In regard to claim 27, Hagstrom discloses a lock assembly wherein connection of the actuator to the extension bolt in the second configuration includes an adaptor body (40, 41, 54, 55, 56, and 53) having a first end (41) connected to the actuator member and a second end (the end connected to 52) connected to the extension bolt, the adaptor body having a length between the first and second ends, the length (53) defining the distance the actuator axis is positioned way from the bolt axis.

In regard to claim 28, Hagstrom discloses a lock assembly wherein the adaptor is connected to the actuator member by mating connection of a projection with a recess (i.e. 40 with 39).

In regard to claim 29, Hagstrom discloses a lock assembly wherein the adaptor is connected to the extension bolt by mating connection of a projection with a receiver (i.e. 53 with 52).

In regard to claim 31, Hagstrom discloses a lock assembly wherein the central lock unit has an exposed side configured to position along an edge of a door (edge of door 1), and the actuator member is located adjacent the exposed side.

In regard to claim 32, the locking assembly wherein the extension bolt is adjacent the exposed side.

In regard to claim 33, Hagstrom discloses a locking assembly wherein the second configuration, the extension bolt axis resides a distance away from the exposed side of the lock, such that the bolt axis to passes through an interior portion of the door.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, 7, 13, 18, 19, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom. In regard to claims 4, 13, 18 and 19, Hagstrom discloses the claimed invention including an adaptor having a first end with a projection (40) configured for mating connection to the actuator (39), and a second end configured for mating securement with the elongated extension bolt (end of 53 with 52). Hagstrom does not teach that the second end of the adaptor is internally threaded and the connection means between the adaptor and elongated extension bolt includes a threaded fastener arrangement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an adaptor wherein the means for

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connecting the second end of the adaptor to the elongated extension bolt includes an internally and externally threaded fastener arrangement between the adaptor and the extension bolt. Using threading as a means to secure one structure to another is well known method in the art, therefore, it would have been obvious at the time of the invention to include threading on the second end of the adaptor for the purpose of preventing the extension bolt from moving side to side. The inventor points out (Page 7 line 2 of Specifications) that the second projection is optionally form as part of the adapter, either with or without threading. The inventor also points out (Page 7, line 4 of Specifications) that the mating arrangement between the adaptor and the extension member, either through friction fit or mechanical fastening. Therefore, it appears that the applicant is allowing one having ordinary skill in the art to determine the desired type of connection between the two members.

In regard to claims 6, 7, 23 and 24, Hagstrom discloses the claimed invention except for the assembly wherein the length of the adaptor body is approximately $\frac{1}{2}$ inch and between $\frac{1}{4}$ and $\frac{3}{4}$ inch. It would have been an obvious matter of design choice to make the adaptor body length approximately $\frac{1}{2}$ inch and between $\frac{1}{4}$ and $\frac{3}{4}$ inch, since a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hagstrom, C.B. Fink, Simon et al., Robert G. Scott, H.W. Cottrel,

Leon M. Wesberry, Flavio R. Quesada, D.D. Reeves Tacheny et al., Elmer R. Smith, Zeus et al..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Schrode whose telephone number is (571)272-1647. The examiner can normally be reached on Mon-Fri 9AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571)272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9/6/05


BRIAN E. GLESSNER
PRIMARY EXAMINER